DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/28/2008 has been entered.

Claim Rejections - 35 USC § 103

2. Claims 1-4, 6, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over: KINOSHITA ET AL (US 5,527,594).

KINOSHITA ET AL an optical tape discloses a clear polyester film substrate, wherein the film is coated on at least one surface with a coating formed from an aqueous coating composition contains 50-100 wt% crosslinkable compounds (e.g., titanium acylate, titanium chelate, etc.), 50-100 wt% binder (e.g., a copolyester containing a sulfonated comonomer such as 5-sodium-sulfo-isophthalic acid in typical amounts of 0.05-8 wt%). The binder has a typical Tg value of 0-60 degrees C. The coatings optionally contain additives (e.g., defoaming agents, antistatic agents, lubricants, UV absorber, etc.). The coating is typically applied to the polyester film by conventional in-line coating methods (i.e., coating and drying between stretching stages). (entire document, line 40-51, col. 2; line 64, col. 10 to line 44, col. 12; line 1-5, col. 13; line 39-45, col. 15; line 39, col. 15; line 8, col. 16; line 1-9, col. 17; line 7-20, col. 20; etc.)

It would have been obvious for one of ordinary skill in the art at the time the invention was made to use aqueous coatings comprising polyester and titanium-based compounds as coating layers for polyester film substrates as disclosed in KINOSHITA ET AL in order to obtain films with improved barrier and adhesion properties. One of ordinary skill in the art would have selected the components in the coating composition in order to obtain the desired transparency (claim 2, 11-12) required for specific applications. The Examiner has reason to believe that the wt% ranges of sulfonated anionic groups disclosed in the references are inclusive of the mol% range recited in claims 3, 6, 8 , therefore the Examiner has basis for shifting the burden of proof to applicant as in In re Fitzgerald et al., 205 USPQ 594. Regarding claims 1, 4, 6, the method of forming the coating layer is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). See MPEP 2113. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the product is unpatentable even though the prior product was made by a

different process. The patentability of a product is based on the product itself, and is not dependent on its method of production.

3. Claims 5, 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

KINOSHITA ET AL (US 5,527,594),

as applied in claim 1,

and further in view of NAKAYAMA ET AL (US 5,662,988).

KINOSHITA ET AL further discloses that it is well known in the art to apply a UV-curable protective coating on the surface of optical tapes to provide protection and improve durability. (KINOSHITA ET AL, line 22-24, col. 25)

NAKAYAMA ET AL disclose that it is well known in the art to apply UV-curable acrylic-based hard coats to recording layers in optical recording media (e.g., tapes) in order to provide abrasion resistance and durability. (NAKAYAMA ET AL, line 5-30, col. 17; line 58-63, col. 18)

It would have been obvious for one of ordinary skill in the art at the time the invention was made to apply known hard coat compositions to the tapes of KINOSHITA ET AL in order to obtain optical films and tapes with improved durability. One of ordinary skill in the art would have selected the components in the coating composition in order to obtain the desired high degree of transparency (claim 7) required for specific applications. Regarding claim 5, the method of forming the coating layer is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the

product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). See MPEP 2113. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the product is unpatentable even though the prior product was made by a different process. The patentability of a product is based on the product itself, and is not dependent on its method of production.

Response to Arguments

4. Applicant's arguments filed 3/18/2008 and 3/28/2008 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 11, 2008

/Vivian Chen/
Primary Examiner
Art Unit 1794